

claimed viscosity limitation to essentially prevent the pesticide from reaching the skin; in other words, the mixture of applicants' Claims 1 and 12 resides substantially on the hair of the animal and hence cannot become transdermal and thus act systemically, thereby overcoming the drawbacks of the prior art.

The Examiner has stated on page 4 of the Office Action that "the means to prevent such effects are only identified as an adaptation, unspecified". Applicants respectfully submit that there is no requirement for specifying the means of providing the stated limitation. To the contrary, MPEP Section 2173.05 (g) states in the first sentence that a "functional limitation is an attempt to define something by what it does, rather than what it is". The next sentence goes on to state that there "is nothing inherently wrong with defining some part of an invention in functional terms". The second paragraph of MPEP 2173.05 (g) states that a "functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art". The Examiner's objection to applicants' "adapted to act non-systemically" language is not understood. Not only is "adapted to" language specifically sanctioned by MPEP 2173.05 (g), the Court of Appeals for the Federal Circuit, in a 1990 case, has specifically stated that it is improper to disregard limitations that include "adapted to" language (see the *Pac-Tec, Inc. v. Amarace* case (903 F.2d 796)). None the less, if the Examiner prefers, the language of Claim 1 can be amended to return to the previous language that the pesticide "acts" non-systemically.

With regard to the Examiner's further statement on page 4 of the Office Action that the requirement for non-systemic action does not preclude systemic action, this comment is not understood. Applicants are concerned only about the non-systemic

limitation requirement, as discussed above with respect to criticality of this limitation. It is only the claimed limitation that the pesticide be “adapted to act non-systemically” that is critical to patentability. Such a limitation will overcome the drawbacks of the prior art, and provides the advantages described in detail on page 6 of the specification of the present application, lines 6-22. Here it is also emphasized in lines 17 and 18 that the active ingredient resides on top of the hair, “i.e. does not operate systemically”.

In this connection, applicants respectfully direct the Examiner’s attention to the following as support that, for example permethrin, acts non-systemically or topically to repel pests:

- (1) Military orders from the Surgeon General at Schafter Medical in Hawaii, in particular section C. (5) (attachment 1);
- (2) A K9 Advantix ad (attachment 2).

With regard with the objection to Claims 20 and 21 as containing new matter, this objection is not understood. In particular, with regard to the statement that there is “no support for a viscosity limitation”, applicants respectfully submit that the upper limitation has already been defined in Claims 1 and 12, on which Claims 20 and 21 indirectly depend. Furthermore, the format followed in Claims 20 and 21 is consistent with the format of original Claims 9 and 16.

### **Claim Rejections – 35 USC § 102**

Applicants’ Claim 1 defines a mixture for application on an animal to provide barrier protection against pests, and provides a pesticide that is adapted to act non-systemically relatively to a host animal. Similarly, Claim 12 provides a method of

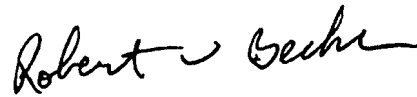
protecting an animal against pests, and provides a non-systemically operating agent that is applied to an animal. Applicants respectfully submit that none of these cited references are an appropriate reference under MPEP 2131, since they do not teach each and every element as set forth in the claim, and certainly not "in as complete detail as is contained in the claim". In particular, the rust inhibitor of Waldstein is to be applied to a ferrous rustable surface and not to an animal. With regard to Mallis, not only is the V-oil carrier cited by the Examiner for cockroaches, which are not found on animals, but the viscosity indicated for the only livestock application given by Mallis (see column 3, line 32) actually teaches away from applicants' viscosity in that it is far lower than applicants' required viscosity range. With regard to the electrostatically sprayable insecticidal formulation of Coffee, those of skill in the art recognize that an electrostatic application is not suitable for application to animals. This is recognized by Coffee as well, which in Claim 1 states that the electrostatically sprayable formulation is suitable "to spray plants". Thus, Coffee in no way teaches or suggests a mixture or application on an animal, as required by applicants' Claims. With regard to Lower, since the cited spinosyns are not soluble in oil, Lower uses silicones. However, silicones are not oil-based carriers, in contrast to the requirements of applicants' Claims 1 and 2. In addition, the viscosity disclosed by Lower is below applicants' claimed range. In view of these distinctions for the cited references, the Examiner is requested to specifically address how these references can in any way teach or suggest applicants' claimed limitations.

Since the present Office Action is a Final Rejection, the undersigned respectfully requests a telephone interview in order to discuss any outstanding

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issues and possible amendments to the claim language in order to place this application into condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert W. Becker". The signature is fluid and cursive, with a large initial "R" and a stylized "B".

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Attachments (1 and 2)